

Applicants: Allan Green et al.
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During a May 10, 2007 telephone conference between Examiner McElwain and the undersigned, Examiner McElwain agreed to reconsider the propriety of the May 4, 2007 Communication upon the filing of this Response.

- 1) *The Examiner has discretion to examine any claim presented in an RCE.*

Applicants respectfully point out that according to M.P.E.P. § 819, it is within the discretion of the Examiner to permit a "shift to claiming another invention" upon the filing of an RCE. Thus, there is no unbending rule that applicant is not permitted to shift inventions upon the filing of an RCE.

- 2) *There is no prohibition against pursuing a different species in an RCE.*

Furthermore, the M.P.E.P. § 819 guidance against allowing a "shift" relates to claims which are "independent and distinct" from claims examined prior to filing of the RCE. Thus, there is no prohibition against pursuing in an RCE different species than the one examined before filing of the RCE. (M.P.E.P. § 821.03 does not relate to the specifics of RCEs.)

Applicants have consistently maintained that SEQ ID NO: 2 and SEQ ID NO: 4 are not different inventions, but are species. SEQ ID NO. 2, which Applicants are reciting in the current claims, is clearly related to SEQ ID NO: 4, which was examined prior to the filing of the RCE. Specifically, as shown in Figure 2 of the subject application, SEQ ID NOs: 2 and 4 (of which SEQ ID NOs. 1 and 3 are corresponding nucleic acid sequences, respectively) have the same length (374 amino acids) and are 97% identical as discussed in the paragraph bridging pages 60 and 61 of applicants' specification.

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Because SEQ ID NO: 2 is related to previously examined SEQ ID NO: 4, Applicants respectfully submit that claims reciting SEQ ID NO: 2 should be examined upon the filing of an RCE.

3) The species now recited (SEQ ID NO: 2) was examined.

Yet furthermore, claims reciting SEQ ID NO: 2 have been examined prior to the filing of the RCE. Prior to the filing of the January 30, 2007 RCE, Applicants were pursuing claims that recited, *inter alia*, both SEQ ID NOs: 2 and 4.

Then, e.g., on page 5 of an August 5, 2005 Office Action, Examiner McElwain stated that the subject specification is "enabling for transgenic Arabidopsis and linseed plants that are transformed with a nucleic acid of SEQ ID NO: 1 or a nucleic acid encoding the delta-12 epoxygenase of SEQ ID NO: 2." Examiner McElwain made a similar statement on page 4 of a July 31, 2006 Final Office Action. To advance prosecution of this application, Applicants have with the RCE amended the previously examined claims to recite the SEQ ID NO which Examiner McElwain considers enabled. Therefore, it would be improper to now not examine claims reciting SEQ ID NO: 2 which Applicants have so amended based on Examiner McElwain's indication of enabled subject matter.

4) The presentation of the pending claims is "responsive."

The May 4, 2007 Communication alleged that Applicants' presentation of the currently pending claims is "non-responsive." Applicants respectfully submit that the currently pending claims have been presented in direct response to Examiner McElwain's indication that the subject specification is "enabling" for claims reciting "a nucleic acid encoding the delta-12 epoxygenase

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of SEQ ID NO: 2." It would be improper to not examine claims which have been presented in direct response to the Examiner's indication of enabled subject matter.

Accordingly, Applicants respectfully request that Examiner McElwain reconsider the propriety of the May 4, 2007 Communication based on the foregoing, and proceed with the examination of the currently pending claims.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invite the Examiner to telephone at the number provided below.

No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Gary J. Gershik

John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents, P.O. Box 1450
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Gary J. Gershik 6/4/07
Date

John P. White
Reg. No. 28,678
Gary J. Gershik
Reg. No. 39,992